

Candidate's examination paper (Examination paper D/1991)

1. By R. 78(2) letters sent to addresses outside the territories of the Contracting States are deemed notified on the date of dispatch. The two months time limit therefore begins on 31.07.90 R. 83(1) and R. 83(4) expires 30.09.90. This is a Sunday and therefore by R. 85(1) the time limit is extended to Monday 01.10.90.
2. Article 79(2) states that the designation of a Contracting State is subject to the payment of the designation fee. Payment of designation fees is checked for under Art. 91(1)(e) and Art. 91(4) states that if the designation fee for a state is not paid in due time in respect of any designated State, the designation of the State is deemed withdrawn. Art. 79(3) states that withdrawal of all designations shall be deemed to be a withdrawal of the EPA. Therefore, Art. 91(4) and Art. 79(3).
3. (a) R. 35(13) provides this.
(b) No. Under Art. 94(1)(b) the Receiving Section has to check that the application satisfies the physical requirements of R. 40. This does not include R. 35(13) as a physical requirement which must be checked. It will only be checked for later by the Examining Division to ensure that application meets the requirements of the Convention and can be granted Art. 97(1).
4. (a) No, any request for extension must be received before the expiry of the period in question R. 84.
(b) Apply for further processing under Article 121 since the time limit was set by the Office and failure to meet it has the direct result that the application will be deemed withdrawn. Will have to pay a fee, complete the omitted act and request further processing Art. 121(2).
(c) Legal Advice No. 13. An application can be filed as soon as the failure is noticed. No need to wait for the notice under R. 69(1). Further processing can be used to prevent deemed withdrawal from ensuing.
5. (a) Amendments under Article 19(1) PCT must be filed with the International Bureau. R. 62.2 If a demand has been filed then they should also be sent to the International Preliminary Examining Authority.
(b) Yes. R. 46.1 PCT states that the time limit under Article 19 shall be two months from the date of transmittal of the international search report to the applicant or 16 months from the priority date of the application (as defined in Art. 2 XI PCT) whichever expires later. The time limit will be deemed met if the claims reach the Bureau before the completion of the preparations for publication [R. 32bis 1c = 15 days before the 18 months time limit of Art. 21(2)(a) for publication].

Note that

6. Article 14(2) PCT states that so long as missing drawings are furnished within the prescribed time limit, the drawings can be included but the international filing date shall be the date on which the drawings are received, that is, it will be changed from that originally assigned under Art. 11 PCT. By R. 20.2(a)(iii) PCT the time limit for the drawings is 30 days from the original filing. This expires, R. 80.3, on 31.10.89.

If not filed by this day the drawings will be considered non-existent.

There is no possibility of correction since R. 91(1)(c) specifically excludes rectification of omissions of entire sheets or elements.

7. (a) Article 86(1) - renewal fees are due in respect of the third and each subsequent year calculated from the date of filing R. 37(1) provides that renewal fees due in respect of a year in advance shall be due on the last day of the month containing the anniversary of the date of filing of the application. Thus the renewal fees for the third year were due on 28.02.91. (Third year runs from 15.02.91 to 14.02.92).

By Art. 86(2) the renewal fee may still validly be paid within 6 months of the due date provided an additional fee is paid (Art. 2(5) RRF sets out that the additional fee is 10% of the belated renewal fee). The additional fee must also R. 37(2) be paid within the 6 months.

R. 83(4) 6 months from 29.02.91 gives a due date of 28.08.91 (not a dies non).

- (b) Yes. The date of receipt of the debit order will be considered as the date of payment so long as there is sufficient funds in the deposit account (6.3 Arrangements for Deposit Accounts). Thus the date of payment will be before the due date of the 28.02.91 and so is in time. There is no problem with paying before the actual due date since R. 37(1) permits such pre-payment up to a year in advance.

Debit orders may be sent by facsimile (Notice of the President 16.05.89).

Legal Advice No. 6. Anyone can pay a fee since this is not a procedural step. Therefore the payment by the unauthorised representative is valid.

8. The technical features of the spinnaker can be protected by a European Patent Application but the aesthetic features cannot [Art. 52(2)(b)]. The best way to protect the aesthetic features would be to file national applications in the Contracting States for registration of the design of the aesthetic features.

The proposed European Patent Application can claim priority from the Japanese Utility Model, Art. 87(1), and must be filed within 12 months of the date of filing of that utility model i.e. in 9 months time. [Japan is a Paris Convention country and Art. 4E(2) of that Convention specifically states that a utility model can claim priority from a patent application and vice-versa. The priority period for both patents and utility models is 12 months Art. 4C(1) PC].

The national industrial design applications can also claim priority from the Japanese utility model applications but by Art. 4E(1) PC the period of priority is that of industrial designs i.e. by Art. 4C(1) PC 6 months. Thus the new applications would have to be on file within 3 months.

If the aesthetic features were produced by some new technical process, that would be protectable.

9. (a) Art. 133(2) states that persons not having a place of business or residence in a Contracting State must be represented by a professional representative. To "be represented" has generally been held to mean that the representative has been both appointed and authorised. In the absence of any authorisation, one is not actually able to represent. Furthermore, T80/84 showed that only a qualified authorised representative can present cases at Oral Proceedings. Therefore it would seem that the answer is no on the basis that T80/84 implies that only the actual representative (i.e. authorised) can present the case.
- (b) The employee can take part in the proceedings as a witness. He may use English to give evidence even though the language of the proceedings is German by R. 2(1). The EPO will have to interpret into German R. 2(5) so long as notice has been given that the witness will use English at least one month before the date of the Oral Proceedings R. 2(1). If was to use Swedish the clients would be responsible for interpretation. R. 2(1).

The employee could also represent his company at that Oral Proceedings provided that he had an authorisation, Art. 133(3). In this case he need not be a professional representative.

10. European Patent Applications may be transferred for one or more of the designated Contracting States Art. 71.

European Patents once granted are subject in each country in which they have effect to the same conditions as national patents in that state. They are independent once granted (with one exception noted below) and transfer of eg. the German national phase of a European Patent can be effected without affecting, or requiring any action on, any of the others.

The exception is provided by R. 61 which applies R. 20 *mutatis mutandis* to any transfer of a European Patent made during the opposition period or opposition proceedings. R. 20 sets out

the requirements for registering a transfer of a European Patent Application and so R. 61 means that a transfer of a patent in the stated periods can also be registered.

The requirements for registration of the transfer are that an original or certified copy of a document showing the transfer must be produced R. 20(1). That document must bear the signatures of both parties to the contract Art. 72. Finally a fee must be paid R. 20(2) (the amount of which is laid down by the President under Art. 3 RRF). The EPO must then register the transfer R. 20(2).

R. 20 applies to A, B and C. It also applies by virtue of R. 61 to D since this is still in the Opposition Period which by Art. 99(1) runs for 9 months from the date of grant i.e. until 30.11.91 and in fact by R. 85(1) since that is a Saturday until the 02.12.91. Thus filing by 01.07.91 or shortly thereafter should ensure registration by the end of the opposition period.

R. 20 also applies to G by virtue of R. 61 since the filing of the appeal prevents the Opposition proceedings from being finally closed (Art. 106(1) an appeal has a suspensive effect) [also applied by R. 66(1) which applies provisions of the department which made the decision from which the appeal is brought to the appeal proceedings. Thus by R. 66(1), R. 61 applies and therefore in turn R. 20 applies].

EFG are outside their opposition periods and therefore will have to be dealt with by the national German procedure.

11. The Enlarged Board of Appeal decision G01/88 states that an opposition can be transferred together with a transferral of a business or the part thereof in the interests of which the opposition was filed. Thus since he has taken over the whole firm the Opposition has also been transferred and he can proceed with it.

However, by R. 56(1) an opposition is to be rejected as inadmissible unless by the end of the opposition period the requirements of inter alia R. 1(1) are complied with. R. 1(1) states that the opposition must be in an EPO official language i.e. English, French or German. The only derogation from this is if the Opponent is entitled by nationality or residence to use another language i.e. an official language of one of the Contracting States (Art. 14(2) Art. 14(4)) in which case the opposition could be filed in such a language and follow up by a translation (time limit R. 6(2)). This only applies to the opponent, not his representative T149/85 and therefore the requirements of R. 1(1) have not been fulfilled. It is too late to do so and the opposition must be rejected as inadmissible.

Unless possibility if still in R. 6(2) time limit i.e. one month from date of opposition filing and new owner Belgian or Dutch!

12. There is no provision in the EPC for X to suspend proceedings. R. 13(1) provides that if the third party who has opened proceedings for entitlement so informs the EPO the proceedings shall be suspended, provided the application has been published, unless the third party agrees to their continuance.

Thus Y could get suspension.

If Y does so then by R. 14 X cannot withdraw the European Patent Application, or any designation thereof, while the proceedings are suspended.

X has neither of the options.

13. (a) Financial difficulties may justify grounds for granting restitutio under Art. 122(1) if they were unforeseeable, not due to any fault on behalf of the applicant and he has made efforts to try and obtain financial support to continue with his application J22/88.
- (b) The proof which the requester must produce is evidence which shows clearly that he has tried to obtain financial aid (following J7/82), that he has done everything possible to meet the time limits in question and that his financial circumstances were not due to some negligence and other failure on his behalf (J22/88). He must as always show that he took due care and attention and that missing the time limit was due to the financial situation as opposed to some other reasons eg. the date had not been watched carefully enough.